

REMARKS

The application has been carefully reviewed in light of the Office Action dated July 25, 2003. Claims 1, 12 and 18 have been amended. Claims 21 and 22 are newly added. Claims 1-22 are pending in this case.

Claims 1-5 and 8-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ieda (U.S. Patent No. 5,847,371). Applicant respectfully request reconsideration.

Claim 1 recites an IC contact unit comprising *inter alia* “a movable support including an IC contact point and a pawl member, said movable support being movable by said depressing member and said pawl member being movable by said depressing member between a first position in which it projects to a card transfer line and a second position in which it retreats upward from said card transfer line, wherein when said pawl member is in said first position and IC card is moved in a card transfer direction, an IC card is prohibited from being transferred to the end of said card transfer line” and “wherein the force of an IC card moved into contact with said pawl member moves said movable support such that said IC contact point contacts with the IC card.”

Ieda discloses an IC card device that does not cause latching of an IC card, thereby allowing the IC card to be discharged even when a discharge signal cannot be supplied to an electromagnetic solenoid. A discharge-detering member (3) is linked to an electromagnetic solenoid (4) and depending upon the suction force of electromagnetic solenoid (4), the discharge-detering member engages card discharging member (2). At IC card insertion, a projecting portion 2c of the card discharging member 2 abuts the third step portion 5c of the card holding member causing the card holding member 5 to move in a clockwise direction (FIGs. 11 and 12).

Ieda fails to teach or suggest an IC contact unit wherein when said pawl member is in said first position and IC card is moved in a card transfer direction, an IC card is prohibited from being transferred to the end of said card transfer line. Ieda also fails to

teach or suggest a movable support including an “IC contact point and a pawl member”...”wherein the force of an IC card moved into contact with the pawl member.” To the contrary, Ieda discloses a latch pawl portion 5d of the card holding member 5 blocks up the insertion opening 10a, thereby preventing discharging of the IC card 40. [Emphasis added]. In addition, the card discharging member 2 moves a pawl member. Accordingly, the rejection of claim 1 should be withdrawn. Claims 2-11 depend from claim 1 and are allowable over Ieda at least for the reasons mentioned above with respect to claim 1.

Claims 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ieda in view of Yasuma et al. (U.S. Patent No. 5,847,371). Applicant respectfully request reconsideration.

Claim 12 recites an IC card reader comprising *inter alia* “an IC contact unit disposed between said transfer rollers and a press roller” and “wherein the force of an IC card moved into contact with said pawl member moves said movable support such that said IC contact point contacts with the IC card.”

As the Office Action notes Ieda fails to teach or suggest the use of transfer rollers. Therefore, Ieda fails to teach or suggest an IC contact unit disposed between said transfer rollers and a press roller. In addition, Ieda fails to teach or suggest an “IC card moved by said transfer rollers into contact with said pawl member moves said movable support such that said IC contact point contacts with the IC card.”

Yasuma does not remedy the deficiency of Ieda with respect to the claim 12 subject matter. Yasuma discloses a connector device for connecting an IC card to a reading and/or writing apparatus. The device of Yasuma allows the leading edge of an IC card to be abutted against an abutment 32. Subsequently the IC card is transported while pushing the abutment as well as the carriage 31 toward the end of the casing 10 remote from the insertion opening 14. Yasuma fails to teach or suggest an IC contact unit disposed between said transfer rollers and a press roller, much less a force being applied to an “IC

card moved by said transfer rollers into contact with said pawl member moves said movable support such that said IC contact point contacts with the IC card.”

Claim 18 recites a method of reading information on an IC card comprising *inter alia* “contacting the IC card with a pawl member of a movable support, wherein said pawl member prevents movement of said IC card in a card transfer direction.” Ieda discloses a pawl member 5d preventing discharging of an IC card, and Yasuma discloses an IC card contacting an abutment 32 in which the abutment 32 and carriage 31 are pushed toward the end of a casing 10 remote from the insertion opening 14. Thus, Ieda and Yasuma even when considered together fail to teach or suggest the limitations of claim 18.

With respect to the obviousness rejection of claims 12 and 18, the Office Action fails to establish a *prima facie* case of obviousness. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, either in the references themselves or in the knowledge of a person of ordinary skill in the art, to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. See e.g., In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573 (Fed. Cir. 1996).

In the present case, Ieda and Yasuma, whether considered alone or in combination, fail to teach or suggest all limitations of claims 12 and 18. Neither Ieda nor Yasuma teach or suggest an IC contact unit disposed between transfer rollers and a press roller. Neither Ieda nor Yasuma teach or suggest a method of reading information on an IC card comprising *inter alia* “contacting the IC card with a pawl member of a movable support, wherein said pawl member prevents movement of said IC card in a card transfer direction. Accordingly, the rejection of claims 12 and 18 should be withdrawn.

Claims 13-17 depend from claim 12 and are allowable over the combination of Ieda and Yasuma at least for the reasons mentioned above with respect to claim 12. Claims

19 and 20 depend from claim 18 and are allowable over the combination of Ieda and Yasuma at least for the reasons mentioned above with respect to claim 18.

Newly added claim 21 recites an IC contact unit, comprising *inter alia* a movable support including an IC contact point and a pawl member, said movable support being movable by said depressing member and said pawl member being movable by said depressing member between a first position in which it projects to a card transfer line and a second position in which it retreats upward from said card transfer line, allowing said IC card to be transferred across said IC contact point to the end of said card transfer line. Neither Ieda nor Yasuma recite such a limitation. Accordingly, claim 21 is allowable over Ieda and Yasuma.

Newly added claim 22 recites a method for reading information on an IC card, comprising *inter alia* transferring said IC card member across said contact point to the end of said card transfer line or transferring said IC card away from said contact point toward an exit/inlet portion. Neither Ieda nor Yasuma recite such a limitation. Accordingly, claim 22 is allowable over Ieda and Yasuma.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: December 29, 2003

Respectfully submitted,

By 

Thomas J. D'Amico

Registration No.: 28,371

DICKSTEIN SHAPIRO MORIN &  
OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorney for Applicant